REMARKS

I. Status of the Claims

Claims 1-31 were originally filed. Claims 7-9, 12, 17-26, 29, and 30 have been canceled. Claims 32-40 have been added. Currently, claims 1-6, 10, 11, 13-16, 27, 28, and 31-40 remain under examination.

II. Claim Rejections

A. 35 U.S.C. §102

In the Advisory Action mailed January 25, 2005, the Examiner maintained the rejection of claims 1-5, 10, 11, 14-16, 27, 28, 31, 33, 35, 37, and 38 under 35 U.S.C. §102(e) for alleged anticipation by Wang *et al.* (U.S. Pat. No. 6,509,448, filed December 13, 2000). Applicants respectfully traverse the rejection.

In raising and maintaining this anticipation rejection, the Examiner has relied on a series of changing theories. First, in the Office Action mailed May 19, 2004, the Examiner stated that the anticipation of SEQ ID NOs:17 and 18 of the present application is based on SEQ ID NOs:1861-1864 in the Wang patent. In the response mailed August 11, 2004, Applicants pointed out that since SEQ ID NOs:1861-1864 are not found in the latest priority document for the Wang patent, U.S. Patent No. 6,504,010 (the '010 patent), as far as these SEQ ID NOs are concerned, the effective filing date for the Wang patent is its actual filing date of December 13, 2000. Accordingly, the Wang patent cannot be anticipatory art to the present application, which was filed October 6, 2000.

The Examiner then relied on a second theory to maintain the anticipation rejection. In the final Office Action of October 18, 2004, the Examiner argued that because the '010 patent recites USSN 60/158,585 and therefore the Wang patent incorporates the contents of the provisional application, and because the present application claims priority to USSN 60/158,585, the Wang patent thus contains the same sequences recited in the pending claims, and the anticipation rejection should be maintained. In the response mailed December 17, 2004, Applicants pointed out that the Wang patent still cannot be used as a §102(e) reference, because

even though the Wang patent incorporates the contents of the priority document of the present application, it still does not have an effective filing date **earlier than** the priority date of the present application, which, to the extent of the disclosure of USSN 60/158,585, is the filing date of USSN 60/158,585. Most importantly, Applicants pointed out that it is inappropriate to use Applicants' own priority document to form the basis of an anticipation rejection.

In the Advisory Action mailed January 25, 2005, the Examiner adopted yet a third theory for sustaining the anticipation rejection. Arguing that SEQ ID NO:18 of the present application is not disclosed in USSN 60/158,585, the Examiner insisted that the anticipation rejection is proper because the present application is not entitled to the filing date of USSN 60/158,585 for the purpose of SEQ ID NO:18. Applicants cannot agree. When addressing the alleged anticipation by the Wang patent, Applicants has never relied upon the filing date of USSN 60/158,585 for the purpose of SEQ ID NO:18; instead, Applicants has consistently taken the position that, as far as the pending claims are concerned, the Wang patent, with an actual filing date of December 13, 2000, does not have an effective filing date **earlier than** the actual filing date of the present application, October 6, 2000. Until the Examiner demonstrates otherwise, no proper basis is established for the anticipation rejection. Without this proper basis, whether or to what extent the present application is entitled to the filing date of USSN 60/158,585 is simply irrelevant to the question of anticipation.

As such, Applicants strongly urge the Examiner to reconsider the decision to maintain the anticipation rejection and promptly withdraw the rejection.

B. 35 U.S.C. §103

Wang et al. in view of Reed et al.

Claims 1,13, 27, 32, 34, 36, 39, and 40 were rejected under 35 U.S.C. §103(a) for alleged obviousness over Wang *et al.* in view of Reed *et al.* (U.S. Pat. No. 6,627,198). Applicants respectfully traverse the rejection.

Applicants contend that the Wang and Reed references cannot be used to form the basis of an obviousness rejection. As stated above, Wang *et al.* is not a §102(e) reference against

the present application. Even if it were to be held a proper reference under §102(e), neither the Wang *et al.* reference nor the Reed *et al.* reference would be available as prior art references for the purpose of supporting a rejection under 35 U.S.C. §103(a). As set forth in 35 U.S.C. §103(c), subject matter developed by another person, which qualifies as prior art only under §102(e), (f), or (g), shall not preclude patentability under 35 U.S.C. §103(a) where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person. In the instant case, Wang *et al.*, Reed *et al.*, and the present application were all assigned to, or obligated to be assigned to the same entity: Corixa Corp., at the time the present invention was made. Accordingly, no §103(a) rejection of the pending claims can be properly made based on Wang *et al.* and Reed *et al.*

As such, Applicants respectfully request that the obviousness rejection based on Wang *et al.* and Reed *et al.* be withdrawn.

Wang et al. in view of Watson et al.

Claims 1 and 6 were rejected under 35 U.S.C. §103(a) for alleged obviousness over Wang *et al.* in view of Watson *et al.* (U.S. Patent No. 6,566,072). Applicants respectfully traverse the rejection.

As discussed above, Wang *et al.* is not available as a §102 prior reference against the present application and is further not available as a §103(a) reference due to the common ownership. On the other hand, Watson *et al.* is cited to provide the element of a polynucleotide sequence encoding mammaglobin and does not relate to any Ra12 polynucleotide or polypeptide sequence. Thus, the combination of the Wang and Watson references cannot support an obviousness rejection. The withdrawal of the §103(a) rejection on this ground is respectfully requested.

C. Provisional Double Patenting Rejection

Claims 1, 2, 11, 14, and 15 were provisionally rejected under the judicially created doctrine of double patenting over claims 1-4 and 7 of co-pending Application No. 09/780,669.

Applicants submit that the Examiner should withdraw the provisional double patenting rejections and allow the claims pending in the present application. According to the MPEP §822.01, "[i]f the "provisional" double patenting rejection in one application is the only rejection remaining in that application, the examiner should then withdraw that rejection and permit the application to issue as a patent..." This is precisely the case in the present application, as the only other rejections, the anticipation rejection based on Wang *et al.* and the obviousness rejection based on Wang *et al.* in view of Reed *et al.* or Watson *et al.*, are not properly established due primarily to the fact that Wang *et al.* and Reed *et al.* are not available as prior art references. On the other hand, USSN 09/780,669 has not been allowed. Thus, Applicants respectfully request that the Examiner withdraw the provisional double patenting rejection and allow the pending claims in the present application to issue.

If, however, a patent issues from USSN 09/780,669 prior to the allowance of the present application, Applicants will consider the possibility of filing a terminal disclaimer.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance and an action to that end is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 925-472-5000.

Respectfully submitted,

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